

## REMARKS

The present request is submitted in response to the Office Action dated April 30, 2008, which set a three-month period for response, making this amendment due by July 30, 2008.

Claims 1-10 are pending in this application.

In the Office Action, claims 1-5 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,301,790 to Zeiler et al in view of U.S. Patent No. 5,074,179 to Omi. Claims 6 and 8-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zeller in view of Omi and in further view of U.S. Patent No. 7,255,144 to Smith.

The Applicants note with appreciation the allowance of claims 6, 8, and 9 as well as the conditional allowance of claims 7 and 10.

In the present amendment, the claims have been amended to more clearly define the present invention over the cited references. The Applicants respectfully submit that the amended claims are not rendered obvious by the cited references, whether viewed alone or in combination.

The device shown in the Zeiler reference has a handle which can be swiveled around the saw housing only when the saw motor is in an "off" position. This element is discussed in Zeiler, column 6, from line 39 and shown in Figs. 4 through 7, in particular, Fig. 5 ("...means for preventing the switch assembly 142 from connecting the motor 18 to the power source when the locking assembly 82 is in the unlocked condition.")

If kickback occurs, the saw in Zeiler jumps up and the saw blade now has means and opportunity to retract into the position of minimum cutting depth and to minimize the kickback energy. The handle, however, transfers force from the user's hand to the saw during kickback, which makes the kickback effect even worse, as the saw then tends to turn quickly around in the user's hand so that the saw blade may cut the user.

The cited reference to Omi does not show any anti-kickback system which would enable the sawblade to retract into minimal cutting depth and to decouple from the handle. As such, Omi appears not to be a relevant reference. The damping apparatus noted by the Examiner is ineffective against kickback and would not minimize its effect in any way.

The Smith reference only shows a power tool that is unable to perform any kickback to a user. The vibration isolating system cannot assist against kickback of a hand power tool. Again, the Applicants submit that Smith is not relevant to the present invention.


The claims as amended therefore are not obvious over the cited reference combinations. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestions supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. ***ACS Hosp. Sys., Inc. v. Montefiore Hosp.***, 221 USPQ 929, 932, 933 (Fed. Cir. 1984).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. (*In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992)).

Since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01.

The application in its amended state is believed to be in condition for allowance. Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



Michael J. Striker  
Attorney for Applicant  
Reg. No.: 27233  
103 East Neck Road  
Huntington, New York 11743  
631-549-4700